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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,508	11/28/2000	Glen T. Anderson	680.0037USU	4904

7590

08/11/2004

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,508

Applicant(s)

ANDERSON, GLEN T.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,7-13 and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 7-13, 15-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of Amendment filed May 13, 2004. Claims 2, 7-13, 15-31 are pending. Claim rejection made under 35 U.S.C. § 112, second paragraph is maintained for the reasons of record. Claim rejections made under 35 U.S.C. § 103(a) are withdrawn and modified to address the amended and new claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 7-13, 15-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially" in claims 2, 7, 12, 13, 23, and 26-31 is a relative term, which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicants' argument that the term "substantially" has appeared in patented claims has been fully considered. However, examiner views that in the instant case the degree of requirement that meets the claimed limitation is defined, particularly because applicants have raised the issue of whether the talc used in LaFleur et al. (US 5658579) meets applicants' sphere-shape requirement.

The remaining claims are rejected as depending on an indefinite claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 2, 7-13, 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rouquet et al. (US 6258345 B1) in view of LaFleur et al. (US 5658579) ("LaFleur").

Rouquet et al. describe a topical composition comprising crosslinked elastomeric organopolysiloxane and spherical polymeric particles with a particle diameter of less than 10 microns in a liquid fatty phase. See abstract. Employing each of the elastomeric organopolysiloxane and the spherical particles in the amount of 2-20 % of the total weight of the composition, is disclosed in col. 3, lines 46 – 58, which meets instant claims 11-13.

While applicants require the "substantially spherical particles" be inorganic, examiner notes that the claim does not exclude the presence of the organic spherical particles as taught in the reference. Nor is there any teaching in the reference that inorganic compounds should not employed in the composition.

Claim 16 is met by the disclosure of the additional ingredients in col. 5, lines 15 – 38. The vehicles of the composition in claim 17 and the method of using the invention in claims 18-20 are described in Examples.

Rouquet fails to teach the particle size distribution of the spherical particles. The reference also fails to teach the inorganic spherical particles recited in Claim 7.

LaFleur teaches powder compositions comprising combination of talc having specified particle size distribution. See col. 2, lines 10 – 34. The reference teaches that

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the talc therein comprises particles having a particle size distribution of 10 microns or less; 15 microns or less; and 20 microns or less. See instant claims 3-5, 9, 10, 24-28. The reference teaches that the invention provides improved coverage, uniformity, and natural look, which are attributed by the particle size distribution of talc. See col. 3, lines 1 – 64. As for claims 1 and 7, examiner takes the position that the prior art renders the claimed particle size distribution of 24 obvious. Based on the prior art teaching that a particle size distribution of 20 microns or less renders the said benefits, it would have been obvious to a routineer to discover a workable particle size distribution by routine experimentation.

Applicants argue that the LaFleur talc is “coarse”, and that natural talc in generally has “platy structure” and thus fails to meet the instant claim limitation. The argument is viewed not persuasive. Examiner notes that since the claim limitation reads “substantially spherical” with no specific disclosure by applicants to indicate what the breath of the sphericalness is necessary to meet the instant claim, it is difficult to determine whether the “coarse” talc used in the LaFleur is outside the scope of the present invention. However, examiner notes that LaFleur in fact teaches combining talc having different sizes and types (treated and untreated talc) to produce enhanced coverage of skin defects. Furthermore, applicants refer to talc as a “substantially” spherical particles which are suitable for the present invention. There is no disclosure in applicants’ disclosure as to how applicants’ talc is different from talc that is conventionally used in cosmetic art. Thus, examiner views that the talc combination of LaFleur meets the instant claim limitation. Furthermore, examiner asserts that the

limitation is met also because the motivation to use spherical particles for cosmetic powder is obviously supplied by the teaching in Rouquet, which specifically employs spherical particles.

Applicants have supplied references submitted on May 13, 2004 to show that talc in natural state has plate-shape. However, these extrinsic evidences do not show that the talc taught by LaFleur is limited to plate-type particles. A more relevant evidence would show, for example, the specific types of the talc taught in the LaFleur in col. 5, lines 38 – 46, are limited to non-spherical powders. The LaFleur reference itself teaches that talc is natural powdered compound but is “ground into various particles sizes” or further treated with hydrophobic materials such as silicon fluids. The reference suggests using treated talc rather than talc in its natural state.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Rouquet by adding the talc particles having specific particle size distributions as suggested by LaFleur because of the expectation of successfully producing cosmetic compositions that provide improved coverage, uniformity, and natural look to the skin. Nothing nonobvious or unexpected is seen in using conventional cosmetic ingredients as suggested by the prior arts for the known purposes.

2. Claims 7, 11-13, 15-20, 25, 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable Nakamura et al. (US 5853711) (“Nakamura”) in view of Abe et al. (US 5989510) (“Abe”).

Nakamura discloses water-in-oil type emulsions comprising crosslinked organopolysiloxane elastomer spherical powder (Torayfil 505C or 506C) having an average particle size of 2-5 microns and silica powder (Aerosil R813 or R972) having an average particle size of not more than 2 microns. See col. 3, lines 1-20; Examples. See instant claims 7, 15. Example I-7 is an emulsion containing the organopolysiloxane elastomer spherical powder, silica, and octylmethoxycinnamate (a UV screening agent). See instant claims 16-20.

Nakamura fails to teach the particle size distribution of silica powder.

Abe teaches granular amorphous silica particles which are spherical and have uniform particle size distribution and filtering property. See col. 2, lines 35-23; col. 6, lines 21 – 50; col. 10, lines 28 - 40. The reference teaches that the particle size distribution is not greater than 2 and particularly not greater than 1.6. See col. 6, lines 21 – 43. The reference also teaches that amorphous silica is used in cosmetics such as powder foundation, paste-like foundation, cream, etc. See col. 11, lines 16- 29. The reference teaches that the method of producing the product efficiently and cheaply. See col. 2, line 28 – 32.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the silica in Nakamura with the Abe amorphous silica particles having good sphericalness and uniform size distribution as motivated by the reference because of an expectation of successfully producing a cosmetic composition with a good filtering agent. The skilled artisan would obviously

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have been motivated to employ the Abe silica because of the expectation that the prior art is cost efficient.

Response to Arguments

Applicant's arguments filed May 13, 2004 have been fully considered but they are not persuasive.

Applicants' arguments regarding the obviousness rejection made over Rouquet in view of LaFleur are addressed above.

Applicants assert that the silica used in Nakamura has an average particle size of not more than 0.2 microns. Examiner respectfully points out that average particle size does not necessarily mean that particle distribution size should be less than the claimed limitation, i.e., 1 micron of particle distribution size. The particle size distribution as recited in the instant claims refers to the uniformity rather than the actual size of the particles. While applicants assert that the Abe silica is not treated with trimethylsilylated or dimethylsilylated hydrophilic hydroxyl groups, examiner notes that that does not necessarily mean that Abe silica cannot be used in cosmetic compositions. The reference teaches the specific application of the silica in cosmetics.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner

SHENGJUN WANG
PRIMARY EXAMINER